

REMARKS

Claims 1, 2, 5, 6, 14, 17-26, and 30 are pending and stand rejected. Claim 1 has been amended not for reasons of patentability but to simply clarify that which was already implied. In view of the amendment and the following remarks, the Applicants respectfully request the Examiner's thoughtful reconsideration.

Claim Objections/Claim Rejections – 35 USC § 112

The Examiner objected to and rejected under §112 Claims 1, 2, 5, 6, and 14. Claim 1 has been amended to address the Examiner's concerns.

Claim Rejections – 35 USC §103

The Examiner rejected Claims 1, 2, 5, and 14 as being unpatentable over US Pub 2002/0032863 to Ha in view of USPN 6,253,323 issued to Cox.. In order for the Examiner to establish a *prima facie* case of obviousness under §103, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

CLAIM 1: Claim 1 is directed to a method for adding a watermark image to a composition and, as amended, recites the following:

1. a watermark service sending a first network communication including imaging service content representing a plurality of selectable watermark images;
2. the watermark service receiving a second network communication including information at least indirectly related to the selection of a watermark image from the plurality of watermark images, the watermark

- service operating on a first network server and having access to the plurality of watermark images;
- 3. the watermark service accessing a target composition that includes one or more graphic references, the target composition being stored on a second network server such that the watermark service accesses the second network server on which the target composition is stored to access the target composition; and
- 4. generating a watermark composition comprising the one or more graphic references of the target composition and a reference to the selected watermark image.

Ha and Cox individually and combined, fail to teach or suggest sending a first network communication including imaging service content representing a plurality of selectable watermark images and receiving a second network communication including information at least indirectly related to the selection of a watermark image from the plurality of watermark images.

Ha discusses a system in which a copy of contents requested by a client are stored by a web server. Data identifying a user of the client, an access time, and an IP address for the client is added to the stored copy. Ha refers to the addition of this additional information to the stored copy as “watermarking.” See Ha, Abstract, paragraph [0029]. Ha also discusses transferring the watermarked content to a client. Ha, paragraph [0034]. Ha, however, does not teach transferring any information to that client that represents a plurality of selectable watermark images. Furthermore, Ha does not teach receiving a network communication selecting a watermark image from the plurality of watermark images.

Consequently, Ha fails to teach or suggest a method that includes sending a watermark service sending a first network communication including imaging service content representing a plurality of selectable watermark images and receiving a second network communication including information at least indirectly related to the selection of a watermark image from the plurality of watermark images. Cox is silent on these points.

For at least this reason, Claim 1 is patentable over the cited references as are Claims 2, 5, 6, and 14 which depend from Claim 1.

Claim Rejections – 35 USC §103

The Examiner rejected Claim 6 as being unpatentable over Ha in view of Cox and in further view of USPN 6,396,594 issued to French. Claim 6 depends from Claim 1 and includes all the limitations of that Claim. For at least the same reasons Claim 1 is patentable, so is Claim 6.

Claim Rejections – 35 USC §103

The Examiner rejected Claims 17-26 and 30 as being unpatentable over Ha in view of Cox and in further view of French.

CLAIMS 17 is directed to a system for adding a watermark to a composition, comprising:

1. a watermark service coupled to a network and having access to imaging service content representing a plurality of selectable watermark images; and
2. a computing device coupled to the network, the computing device configured with a browser, wherein the browser is configured to:
 - a. receive the imaging-service content from the watermark service, the imaging-service content including a reference for each of the plurality of selectable watermark images,
 - b. enable a user of the browser to select a watermark image from the plurality of selectable watermark images represented by the imaging-service content,
 - c. obtain the reference to the selected watermark image for integration with a target composition stored in a data storage device communicatively coupled with the computing device, the target composition including one or more graphic references, and

- d. at least initiate the generation of a watermark composition comprising the reference to the selected watermark image and the one or more graphic references.

Claim 17 recites that the browser is configured to receive imaging service content from a watermark service where that imaging service content includes a reference for each of a plurality of selectable watermark images. The Examiner fails to assert that any one reference or combination thereof teaches receiving, from a watermark service, imaging service content that includes a reference for each of a plurality of selectable watermark images.

The Examiner asserts that Ha teaches a browser that can receive imaging service content but does not assert that Ha teaches or suggests that the imaging service content includes the plurality of references as recited by Claim 17. The Examiner admits that Ha does not teach enabling a user to select from a plurality of watermark images. Instead, the Examiner asserts that French does. However, the Examiner does not assert that French (or Cox) teaches or suggests a browser that is configured to receive, from a watermark service, imaging-service content that includes a reference for each of the plurality of selectable watermark images.

Consequently, the Examiner has failed to establish a *prima facia* case for obviousness with respect to Claim 17. For at least this reason, Claim 17 is patentable over Ha, Cox, and French as are Claims 18-24 which depend from Claim 17.

CLAIM 25 is directed to a computer-readable medium storing computer readable instructions for:

1. receiving imaging-service content representing a plurality of watermark images;;
2. enable a user to select a watermark image from the plurality of watermark images represented by the imaging service content;
3. obtain a reference to a watermark image selected by the user;

4. identify one or more compositions designated for integration with the reference to the selected watermark image, each of the one or more compositions including one or more graphic references;
5. for each of the one or more compositions, initiate the generation of a watermark composition comprising the reference to the watermark image and the one or more graphic references of that composition at least one target composition; and
6. initiate the storage of the one or more generated watermark compositions in a personal imaging repository.

With respect to the instructions for identifying one or more compositions designated for integration with the reference to the selected watermark image, each of the one or more compositions including one or more graphic references receiving imaging-service content representing a plurality of watermark images, the Examiner simply states “See the analogous arguments of claim 17.” Claim 17 does not recite such instructions or a components having such capability. As such the Examiner made NO analogous arguments. As such the Examiner has failed to assert that and one reference or combination thereof teaches the instructions for identifying as recited in Claim 25.

Consequently, the Examiner has failed to establish a *prima facia* case for obviousness with respect to Claim 25. For at least this reason, Claim 25 is patentable over Ha, Cox, and French as are Claims 26 and 30 which depend from Claim 25.

Conclusion

The foregoing is believed to be a complete response to the outstanding Office Action. Claims 1, 2, 5, 6, 14, 17-26, and 30 are felt to be in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited.

Respectfully submitted,
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